

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

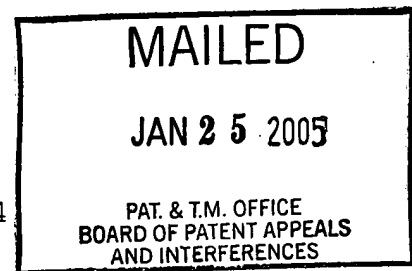
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODGER BURROWS

Appeal No. 2004-2110
Application No. 09/910,654

HEARD: DECEMBER 8, 2004



Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which constituted all the claims in the application. An amendment after final rejection was filed on October 17, 2003 and was entered by the examiner. This amendment cancelled claim 16. Therefore, this appeal is directed to the rejection of claims 1-15, 17 and 18.

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The disclosed invention pertains to a method and apparatus for electronically generating, storing and retrieving airline ticket agency coupon data.

Representative claim 1 is reproduced as follows:

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in a format of an agent coupon.

The examiner relies on the following references:

Friedes et al. (Friedes) 5,521,966 May 28, 1996

"Field Investigations and Fraud Prevention Program," Industry Agents' Handbook, pp. 1-2, (Section 70.0, 2000 Ed.) (Hereinafter referred to as IAH).

Prior art submitted by appellant relating to events involving Airlines Reporting Corporation (ARC).

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Claims 1-15, 17 and 18 stand rejected under 35 U.S.C. § 102(f) because appellant did not invent the claimed subject matter. Claims 1-15, 17 and 18 also stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Friedes in view of IAH.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support the rejection of the claims under 35 U.S.C. § 102(f). We are also of the view that the prior art relied upon does not support the examiner's

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rejection of the claims under 35 U.S.C. § 103. Accordingly, we reverse. We enter a new rejection, however, using our authority under 37 CFR § 41.50(b).

We consider first the rejection of claims 1-15, 17 and 18 based on the examiner's finding that appellant did not invent the subject matter of the claimed invention. The examiner's finding results from the examiner's consideration of the prior art submitted by appellant representing events involving the Airlines Reporting Corporation (ARC). It is essentially the examiner's position that the claimed invention represents nothing more than the recitation of a new policy proposed by ARC in which agent coupon data could be stored electronically rather than in paper form (answer, pages 3-5).

Appellant argues that independent claims 1 and 15 recite the storage of agent coupon data electronically whereas ARC only describes the storage of agent coupon data as an actual image of the agent coupons. Appellant argues that there are several disclosures within ARC that indicate that ARC was only proposing the storage of an image of an agent coupon and not the electronic

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storage of agent coupon data. Appellant also notes that the rejection is not based on a single document as required, but instead, is based on a plurality of separate documents by ARC and the Travel Weekly News (brief, pages 9-15).

The examiner responds that ARC disclosed that agents "can now print agent coupon[s] on non-accountable stock or capture the coupon data on an optical media" (answer, page 5, emphasis added by examiner). The examiner finds that the disclosure of capturing coupon data indicates that the data is stored electronically. The examiner also notes that it would have been obvious to store the data as an image file or a text file. The examiner notes that it was well known that image data can be stored in electronic form for reconstruction of the image (answer, pages 6-11).

Appellant responds that when all of the disclosures of ARC are considered as a whole, it is clear that ARC did not contemplate the electronic storage of agent coupon data (reply brief, pages 2-5, 7-11).

We will not sustain the examiner's rejection of the claims on appeal under 35 U.S.C. § 102(f). We agree with appellant that ARC, when considered in its entirety, only

discloses that agent coupon data should be stored in optical form. The attempt by the examiner to read electronic storage of coupon data into the ARC disclosure is based on speculation. Although the examiner has given reasons why the electronic storage of the coupon data would have been obvious to the artisan in view of ARC, the rejection before us is based on anticipation and not on obviousness. We address this question of obviousness in our new ground of rejection set forth below.

We now consider the rejection of claims 1-15, 17 and 18 under 35 U.S.C. § 103 based on the teachings of Friedes and IAH. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally

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available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those

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arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

With respect to independent claims 1 and 15, the examiner's rejection is set forth on pages 5-6 of the answer. The examiner essentially finds that since Friedes teaches the electronic sale of an airline ticket, and since IAH allowed the electronic storage of an agent's coupon, then it would have been obvious to the artisan to maintain the agent coupon data in Friedes as an electronic file, available for retrieval and printing.

Appellant argues that Friedes is not analogous art because Friedes relates to the paperless storage of images of a smart card whereas the claimed invention relates to the storage of data associated with agent coupons from which an actual facsimile of the agent coupons can be created on demand. Appellant notes that there is no mention of an agent coupon in Friedes. Appellant also argues that there is no suggestion in either reference to combine their teachings in the manner proposed by the examiner. Appellant asserts that the teachings

of the two references would lead the artisan in opposite directions. Appellant also argues that IAH relates to optical storage of coupon data and not to electronic storage of such data (brief, pages 18-23).

The examiner responds that it is inherent that when Friedes generates and stores the electronic ticket information it must also generate and store the agent coupon data as per the ARC regulations. The examiner also argues that ARC and IAH teach that the agent coupon data must be electronically stored (answer, pages 11-14).

Appellant responds that Friedes does not once mention agent coupon data, and that it was error for the examiner to extrapolate the teachings of Friedes to include agent coupon data. Appellant also notes that Friedes does not involve a travel agent so that no agent coupons are necessary and the regulations of the ARC are irrelevant (reply brief, pages 5-7, 11-13).

We will not sustain the examiner's rejection of independent claims 1 and 15. We agree with appellant that there is no reasonable basis for combining the teachings of Friedes and IAH. The entire premise of the examiner's rejection is that an

agent coupon must be generated in Friedes which is governed by regulations established by ARC. There is no mention, however, of a travel agent or agent coupon in Friedes. Friedes appears to be a smart card system for use directly with the airlines themselves. Friedes specifically discloses that "[t]he traveler need not go to a travel agency or airline office in order to obtain the ticket" (column 7, lines 12-13). Friedes also discloses that the smart card is verified by the flight attendant, who presumably works for the airlines, and that the smart card system eliminates the need for a separate document or piece of paper at the conclusion of the transaction (column 7, lines 7-12). Thus, the suggestion that Friedes somehow requires an agent coupon is contrary to the very teachings set forth within the reference. The premise for the examiner's rejection could only come from an improper attempt to reconstruct the claimed invention in hindsight.

Since we have not sustained the examiner's rejection with respect to independent claims 1 and 15, we also do not sustain the rejection with respect to any of the dependent claims.

In summary, we have not sustained either of the rejections as formulated by the examiner. Therefore, the decision of the examiner rejecting claims 1-15, 17 and 18 is reversed. We make the following new ground of rejection using our authority under 37 CFR § 41.50(b).

We reject claims 1-15, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the prior art submitted by appellant which has collectively been labeled ARC. We incorporate the findings made by the examiner in rejecting these claims under 35 U.S.C. § 102(f) except for the finding that ARC discloses the electronic storage of coupon data. Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the examiner, we agree with the examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that coupon data should be stored in optical form. At the time this application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multimedia network transmission. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the

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artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED - 37 CFR § 41.50 (b)

Gerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

JOSEPH F. RUGGIERO

JOSEPH F. RUGGIERO
Administrative Patent Judge

BOARD OF PATENT
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